

**REMARKS**

Review and reconsideration on the merits are requested.

At the time of rejection, claims 1 and 4-10 were rejected, and claims 2, 12-24 and 26 remained withdrawn from consideration.

The prior art: U.S. Patent 6,420,010 Hasegawa et al (Hasegawa); U.S. Patent 5,958,552 Fukuda et al (Fukuda).

The rejection: claims 1 and 4-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasegawa in view of Fukuda.

The above rejection, in light of the amendments to the claims, is respectfully traversed.

The Examiner's position was that Hasegawa exactly discloses Applicants' white biaxially oriented polyester film as claimed in claim 1, except for a specific recitation of average glossiness and that the polyester film has a thickness of from 100 to 250  $\mu\text{m}$ . However, the Examiner sets forth in the first full paragraph on page 3 of the Office Action, that he considers that the glossiness value of subparagraph (2) of claim 1 would be inherently found within the film of Hasegawa. Fukuda is cited as teaching a film thickness that overlaps subparagraph (5) of claim 1.

As expressed at the bottom of page 3 of the Office Action, the Examiner considers that the film thickness of claim 1 will be obvious to one of ordinary skill in the art working in the ink jet printer field. The Examiner advances that the skilled artisan would modify the film of Hasegawa to have a thickness as expressed in Fukuda, since that is the thickness that is required for ink jet printing.

In paragraph 5 on page 4 of the Office Action, the Examiner responds to Applicants' arguments for patentability as expressed in the "Remarks" section of the Amendment submitted April 24, 2003. The Examiner's basic position appears to be that Applicants' main argument deals with intended use, but that the claimed film is not limited to ink jet printer use only. The Examiner suggest that the preamble of claim 1 be amended to recite "A white biaxially oriented polyester ink jet recording film."

Claim 1 is amended to include the language that the Examiner suggests.

Further, claims 5 and 6 are, in substance, included into claim 1, claims 5 and 6 being canceled. This is a limitation to claim 1.

#### The Features and Advantages of the Present Invention

The white polyester ink jet recording film of the present invention has features (1) to (7) as set forth in amended claim 1. An ink jet recording film having such specific features (1) to (7) is excellent in whiteness, opacifying property and glossiness. Further, it exhibits a small thermal shrinkage factor under favorable conditions (see claim 4).

#### The Prior Art

##### Hasegawa

Hasegawa relates to a polyester film which is laminated on a metallic can. The Hasegawa film is a laminate of three layers each formed of a copolyester. Hasegawa contains no suggestion whatsoever regarding any use of the Hasegawa laminated film in the ink jet printer environment.

Hasegawa discloses that the Hasegawa laminated film has a “thickness of from 6 to 75  $\mu\text{m}$ , more preferably from 10 to 75  $\mu\text{m}$ , especially from 15 to 50  $\mu\text{m}$ ”. See Hasegawa at column 9, lines 15-17. Further, the laminated films obtained in Examples 1 to 21 in Hasegawa have a thickness of 20  $\mu\text{m}$ , and the laminated films obtained in Examples 22 to 40 in Hasegawa have a thickness of approximately 17-18  $\mu\text{m}$ . Hasegawa thus simply discloses films having a very small thickness which are to be laminated onto a metallic can.

Applicants respectfully submit that since the films disclosed in Hasegawa are extremely thin, quite clearly the same could not and would not satisfy the requirement of optical density (7) set forth in claim 1 of the present application.

#### Fukuda

Fukuda discloses a laminated film for use in OHP (overhead projectors). Specifically, Fukuda discloses a laminated film having a specified hydrophilic coating layer.

Fukuda is primarily directed to the use of a layer formed of a specified composition as a hydrophilic coating layer; Fukuda contains no disclosure regarding any features of a base film of a laminated film as in the present invention.

Fukuda is silent and contains no disclosure or suggestion regarding whiteness factor (6) and optical density factor (7) of the film of the present invention as set forth in amended claim 1.

#### Summary of Applicants' Position

The present invention is directed to a white biaxially oriented polyester film which satisfies requirements (1) to (7) set forth in amended claim 1, which white biaxially oriented


AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application NO.: 09/762,145

polyester film has remarkably excellent features for receiving and retaining an ink jet printer image.

Applicants respectfully submit that Hasegawa neither describes nor suggests any film similar to that of the present invention nor would one of ordinary skill in the art be motivated to reach the film of the present invention having or meeting requirements (1) to (7) as called for in amended claim 1 from the combination of Hasegawa and Fukuda.

Withdrawal of all rejections and allowance is requested.

Respectfully submitted,

  
Peter D. Olexy, P.C.  
Registration No. 24,513

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: November 6, 2003